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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,439	04/13/2004	Volkmar Teichgraber	30882/DP016	4835
4743 7590 08/01/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER JABR, FADEY S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 08/01/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/823,439

**Applicant(s)**

TEICHGRABER ET AL.

**Examiner**

FADEY S. JABR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 December 2007 has been entered.

### ***Status of Claims***

Claim **10** has been newly added. Claims **1** and **9** have been amended. Claims **1-10** are pending and are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims **1** and **9** have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims **1-8** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims **1-8** are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to

another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-8 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-5 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Avant, U.S. Patent No. 6,976,621 B1, hereinafter referred to as Avant.

As per Claims 1, 3 and 8-10, Avant discloses a system and method comprising:

- detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpiece at a sorting station (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- transmitting the detected information and an appertaining identification code to an interface computer and storing the detected information and the appertaining pertinent identification code (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- accessing the stored information and the stored identification code and determining address information on the basis of the detected and stored information (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- comparing the detected address information with address information present in a database (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- associating the detected address information with new address information on the basis of the comparison that has been carried out (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35);
- transmitting the associated new address information and the appertaining identification code to the interface computer (C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35, also see Figure 11);
- detecting the identification code applied onto the mailpieces and applying the new address information onto the mailpiece wherein the new address information is derived from the information read from the mailpiece and is applied as a function of

the identification code ((C. 5, lines 60 – C. 6, lines 12, C. 8, lines 9-10, C. 8, lines 55-67, C. 9, lines 7-35, C. 14, lines 38-55).

As per **Claim 4**, Avant discloses applying the new address information onto the mailpiece in coded form (C. 6, line 30).

As per **Claim 5**, Avant discloses wherein the address information comprises a barcode (C. 6, line 30).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avant in view of Didriksen, International Publication No. WO 00/00300, hereinafter referred to as Didriksen.

As per **Claims 2 and 7**, Avant fails to disclose processing the mailpieces according to a *two-stage process*. However, Didriksen teaches a sortation sequence may be used at the first and/or at the second item processing installation as well as in distributing of items and during

final delivery of items at the respective destination locations (pp. 10, lines 15-26, pg. 15, lines 16-25, pp. 28, lines 4-22).

It would have been obvious to one of ordinary skill in the art to include in the mailing system of Avant the ability to further process mail items as taught by Didriksen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claim 6, Avant fails to *explicitly* disclose wherein the address information at least partially in plain text. However, Didriksen teaches capturing a first image of a printed or written address block provided on the parcel (pp. 25, lines 17-19).

It would have been obvious to one of ordinary skill in the art to include in the mailing system of Avant addresses in text form as taught by Didriksen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### *Conclusion*

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

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respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3628

FSJ

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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401  
Dulany Street, Alexandria, VA 22314

/F. S. J./

Examiner, Art Unit 3628

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628